

3577-80



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Applicant : Nobuaki Onagi ✓
Serial No. : 08/891,308 ✓
Filed : July 10, 1997 ✓
For : SUPER RESOLUTION INFORMATION REPRODUCTION BY
TRACKING ADDRESS INFORMATION IN NORMAL
RESOLUTION ✓
Examiner : K. Chu ✓
Art Unit : 2651 ✓

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#18 Reply Brief
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REPLY BRIEF ON BEHALF OF APPLICANT

Assistant Commissioner for Patents
Washington, DC 20231

S I R :

Appellant acknowledges receipt of the Examiner's Answer mailed from the U.S. Patent and Trademark Office on May 7, 2001. Appellant wishes to address points of argument set forth in the Examiner's Answer.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed: Assistant Commissioner for Patents, Washington, D.C. 20231, on June 19, 2001.

Gerald Levy

Signature

Date of Signature

The Commissioner is hereby authorized to charge any additional Fees which may be required, or credit any overpayment to:
Account No. 50-1145.

The Examiner argues that previously amended features, high pit density and low pit density, which were added to overcome a 103 rejection of the parent application were not included in claims 11, 14, and 20 of the reissue application. The novel feature of the original invention lies in reproducing the information pits with a density higher than the density of the address pits intermingled on the same optical disk, by use of the same light spot. Use of the terms "first pit density" and "second pit density" reflect this high/low pit density arrangement for claims 11, 14, and 20.

The Examiner argues that the statement "Utilizing a super resolution reproduction means ..." was included in the Examiner's Statement of Reasons for Allowance (Paragraph 6 of Notice of Allowability for Application No. 08/126,515 dated March 07, 1995). As a result of this inclusion, the Examiner argues that the applicant acquiesced to the presence of this limitation. However, by not responding to the Examiner's Statement in the Notice of Allowability, the applicant did not acquiesce to the statement. Under the Code of Federal Regulations applicable at the time of allowance,

The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the Examiner. Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the Examiner (emphasis added). Reasons for allowance, 37 C.F.R. §1.109 (1994).

A copy of the section is included within this reply. Apparently, the Examiner was in error in applying the current Code of Federal Regulations to the Notice of Allowability for the parent application.

As stated in the Appeal Brief, use of the term "super resolution reproduction" was added by the December 21, 1994 amendment as satisfying a request for clarification (Item 6 of Office Action dated 26 September 1994).

CONCLUSION

For all of the above reasons and for those set forth in Appellant's previous brief, it is submitted that the claims are allowable.

Respectfully submitted,



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code of federal regulations

**Patents,
Trademarks, and
Copyrights**

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Revised as of July 1, 1994

**CONTAINING
A CODIFICATION OF DOCUMENTS
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§ 1.108

lication, or place where a copy can be found, shall be given.

(b) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

[46 FR 29182, May 29, 1981]

§ 1.108 Abandoned applications not cited.

Abandoned applications as such will not be cited as references except those which have been opened to inspection by the public following a defensive publication.

[50 FR 9381, Mar. 7, 1985]

§ 1.109 Reasons for allowance.

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

[46 FR 29182, May 29, 1981]

§ 1.110 Inventorship and date of invention of the subject matter of individual claims.

When more than one inventor is named in an application or patent, the Patent and Trademark Office, when necessary for purposes of an Office proceeding, may require an applicant, patentee, or owner to identify the inventive entity of the subject matter of each claim in the application or patent. Where appropriate, the invention

37 CFR Ch. I (7-1-94 Edition)

dates of the subject matter of each claim and the ownership of the subject matter on the date of invention may be required of the applicant, patentee or owner. See also §§ 1.78(c) and (d).

(Approved by the Office of Management and Budget under control number 0651-0018)

[50 FR 9381, Mar. 7, 1985]

ACTION BY APPLICANT AND FURTHER CONSIDERATION

AUTHORITY: Secs. 1.111 to 1.113 also issued under 35 U.S.C. 132.

§ 1.111 Reply by applicant or patent owner.

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections